

REMARKS

The applicant has carefully considered the official action dated December 19, 2005, and the references cited therein. Claims 1-34 are pending in this application. In the official action, claims 1-15 were allowed and, thus, those claims will not be discussed further herein. Claims 27, 28, 30, and 31-34 were rejected under 35 U.S.C. § 251 as based on a defective reissue declaration; claims 16, 21, 25, 27, 28, 31, 32, and 34 were rejected under 35 U.S.C. § 103(a) as unpatentable over Osako et al. in view of Meier; and claims 17-20, 22-24, 26, 29-30, and 33 were rejected under 35 U.S.C. § 103(a) as unpatentable over Osako et al. in view of Meier and Harris, Jr. et al. By way of this response, the applicant traverses the rejections.

As an initial matter, the applicant respectfully submits that a reissue declaration under 37 C.F.R. § 1.175 was filed with the Patent Office on November 7, 2005, a courtesy copy of which is enclosed. Accordingly, the applicant respectfully requests withdrawal of the 35 U.S.C. § 251 rejection.

Now turning to the art rejections, the applicant respectfully submits that claim 16 is allowable over the art of record. Claim 16 is directed to a binding line and recites, *inter alia*, a feeder system operatively associated with at least one packer box that includes a conveyor, a plurality of feeders, and a controller in communication with the feeders to activate a selected one of the feeders at a time. The applicant respectfully submits that one of ordinary skill in the art would not have been motivated to modify the teachings of Osako et al. in view of Meier to make a binding line having each and every element recited in claim 16.

One of ordinary skill in the art would not have been motivated to modify the Osako et al. system based on the Meier teachings. Osako et al. teach a binding line to make a mass quantity of identical books (i.e., text books) by feeding a signature unconditionally from

every feeder in the binding line system for each and every signature location on a binding conveyer. In contrast, the Meier system produces printed products having different numbers of signatures. The Meier system uses the controller to selectively feed individually supplied printed products for some printed product groups, but not others. Because the Osako et al. system feeds one of each signature for every book unconditionally, it would not need the Meier controller to selectively feed some signatures but not others. Such a modification of Osako et al. to activate a selected one of the feeders would serve no useful purpose and would be unnecessary overhead.

The examiner contends that one of ordinary skill in the art would modify the Osako et al. system to use the Meier controller for the purpose of determining the degree of filling of a packer box and controlling the supply speeds of the feeder system accordingly. The applicant respectfully disagrees. The fact that a prior art reference can be modified is insufficient to support a prima facie case of obviousness. *See* MPEP § 2143.01. Instead, “there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). Osako et al. do not teach or suggest any desire whatsoever to determine the degree of filling of the Osako et al. signature feeders. The alleged motivation – “for the purpose of determining the degree of filling of a packer box” – is drawn from the Meier teachings and cannot serve as a basis to support the suggested modification of the Osako et al. system. *Id.*

Another alleged motivation provided in the official action is based on making a more efficient and less costly system. However, a mere assertion of a motivation without clear documentary evidence amounts to “official notice,” which must only be asserted when the facts asserted “are capable of instant and unquestionable demonstration as being well known.” *See* MPEP § 2144.03. Taking “official notice of the fact that it is desirable to make

something faster, cheaper, better, or stronger without the specific support of documentary evidence” may not be unreasonable in appropriate circumstances. *See id.* However, under the circumstances of the instant application, it is not well known that modifying the Osako et al. system to incorporate the Meier controller would result in a more efficient and less costly system. On the contrary, adding the Meier controller to the Osako et al. system would more likely result in a more costly and inefficient system. Specifically, the cost of the Osako et al. system would increase by adding the Meier controller, and the Meier controller, serving an unnecessary purpose (i.e., determining the degree of filling of a packer box) in the Osako et al. system, would be completely superfluous and would merely add unnecessary overhead to the Osako et al. system without serving any necessary purpose, thus, making it less efficient.

The need for a controller in the Meier system to determine a degree of filling and to control the supply speeds arises from the unpredictable supply speed for each individually supplied printed product due to the non-continuous delivery of each individually supplied printed product. However, the supply speeds in the Osako et al. system are not unpredictable because every feeder of the Osako et al. binding line feeds in an unconditional, continuous manner.

In addition to unconditionally feeding every signature, the Osako et al. system also carries the signatures along the binding line at a predetermined conveying speed (e.g., a constant speed) and at predetermined intervals (e.g., the feeders feed signatures at constant, predetermined intervals). *Osako et al.*, col. 6, line 6; col. 8, ll. 61-62; col. 9, ll. 24-29. The predetermined conveying speed and intervals result in a constant signature supply speed by each of the Osako et al. feeders, which results in a deterministic rate of signature consumption by each feeder. In contrast, the irregular supply speeds of the Meier system

result in non-deterministic printed product consumption rates and, thus, Meier requires the controller to detect a degree of filling during operation.

In the Osako et al. system, one of ordinary skill in the art could easily calculate a predetermined feeder supply speed for each of the Osako et al. feeders based on the deterministic signature consumption rates without using the Meier controller. The predetermined supply speed can then be used to supply signatures to each feeder only when necessary as indicated by the predetermined feeder supply speeds.

Calculating the predetermined feeder supply speeds for the Osako et al. system produces the same results (i.e., the same feeder supply speed) as would using the Meier controller in the Osako et al. system. However, calculating the predetermined feeder supply speed serves the Osako et al. cost concerns better than would modifying the Osako et al. system to use the Meier controller, which would require adding at least the Meier control processor (14), the Meier memory (15), a plurality of the Meier supply control detectors (11), and all control software necessary for the control processor (14) to use the control detectors (11) to determine when to supply the feeders.

Contrary to the assertion set forth in the official action, using the Osako et al. system to feed signatures of different thicknesses would not motivate one of ordinary skill in the art to modify the Osako et al. system to use the Meier controller. One of ordinary skill in the art could easily calculate the predetermined feeder supply speed for each feeder based on its corresponding signature thickness. By calculating a feeder supply speed based on the predetermined conveying speed, intervals, and signature thicknesses, it would be readily apparent to one of ordinary skill in the art that a first feeder supplied with signatures that are

relatively thicker than those of a second feeder would require a relatively higher supply speed. Even if the Meier controller provided the same results, it would do so at a higher cost.

Assuming *arguendo* that the Osako et al. system could be modified to use the Meier controller, the costs of such a modification would outweigh its benefits at least in view of the above-outlined methods of calculating predetermined feeder supply speeds based on the predetermined conveying speed, intervals, and signature thicknesses. The Meier controller provides no greater efficiency than do the above-outlined feeder supply speed calculations. On the contrary, adding the Meier controller to the Osako et al. system would result in less efficiency because the Osako et al. system would be more expensive (e.g., higher cost of goods to make the system, higher engineering costs to modify the system, higher maintenance costs to fix or update controller software and hardware, etc.) while providing the same output as it does without the Meier controller.

The applicant respectfully submits that for at least the foregoing reasons, one of ordinary skill in the art would not be motivated to modify Osako et al. system to use the Meier controller. Accordingly, the applicant respectfully submits that independent claim 16 and all claims dependent thereon are in condition for allowance.

The applicant respectfully submits that independent claims 21, 27, and 31 are also allowable over the art of record for at least some of the reasons set forth above in connection with the remarks for independent claim 16. Accordingly, claims 21, 27, and 31 and all claims dependent thereon are also in condition for allowance.

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In view of the foregoing, the applicants respectfully request reconsideration of this application. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark G. Hanley", is written over a horizontal line.

Mark G. Hanley
Registration No. 44,736
Attorney for Applicant
Hanley, Flight & Zimmerman, LLC
(at customer number **34431**)
20 North Wacker Drive
Suite 4220
Chicago, Illinois 60606
312.580.1020

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